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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,514	04/30/2001	K. Roger Aoki	D2929CON	3428

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EXAMINER	
FORD, VANESSA L	

ART UNIT	PAPER NUMBER
1645	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/845,514	AOKI ET AL.	
	Examiner	Art Unit	
	Vanessa L. Ford	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,17-26,28 and 29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 17-26, 28 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 17, 2004 has been entered. Applicant's amendment is acknowledged. Claims 1, 17 and 26 have been amended. Claims 10-16 and 27 have been cancelled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office Action.

Rejection Withdrawn

3. In view of Applicant's amendment and response (filed October 16, 2003), the rejection of claims 1-9 and 17-26 under 35 U.S.C. 112, second paragraph, page 2, paragraph 4 has been withdrawn in the Final Office action mailed January 15, 2004. The Office apologizes for the oversight.

4. In view of Applicant amendment the following rejections are withdrawn:

a) rejection of claims 1,6, 17, 22 and 26-27 under 35 U.S.C. 103(a), pages 3-4, paragraph 4 of the previous Office action.

b) rejection of claims 1,6, 17, 22 and 26-27 under 35 U.S.C. 103(a), pages 5-6, paragraph 5 of the previous Office action.

c) rejection of claims 1,6, 17, 22 and 26-27 under 35 U.S.C. 103(a), pages 8-9, paragraph 7 of the previous Office action.

Rejection Maintained

5. The rejection under 35 U.S.C. 103(a) is maintained for claims 28-29 for the reason set forth on pages 6-7, paragraph 6 of the last Office action.

The rejection was on the grounds that Ludlow et al do not teach using a composition comprising at least two neurotoxins selected from the group consisting of botulinum toxin types A, B, C, D, E, F and G to treat patients suffering from torticollis.

Schantz et al teach that Botulinum toxin A can provide profound symptomatic relief from humans suffering from a wide variety of disorders characterized by involuntary movements of muscle groups (including torticollis) (page 83, 2nd column and page 84, Table 2).

The combination of Ludlow et al and Schantz et al as set forth *supra* differs by not teaching the combination of A and B or A and E.

Sugiyama teaches that are seven (A-G) known serotypes of botulinum toxin that have been isolated and characterized. Sugiyama teaches antigenically different neurotoxins have a common and unique pharmacological action (page 427, 2nd column).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to substitute any of the B,C,D,E or G for the "F" neurotoxin in the combination of Ludlow et al and Schantz et al as combined *supra* because Sugiyama teaches that these antigenically different neurotoxins have a common and unique pharmacological action and the substitution of the one for the other would be readily expected to work given that two of the individual neurotoxins have been individually shown to be effective for the treatment of torticollis.

Applicant urges that prior art references alone or in combination do not teach the claimed invention. Applicant urges that the enhancement obtained from the combination of neurotoxins is an advantage that is not disclosed, taught or suggested by the prior art.

Applicant's arguments filed May 17, 2004 have been fully considered but they are not persuasive. The applicant's arguments are not commensurate in scope with the disclosure or claims. Claims 28-29 are drawn to therapeutic compositions (i.e. products). There is no limitation in claims 28-29 that is directed to " increased enhancement of muscle contraction relief". The specification has merely disclosed the use of various combination of neurotoxin (e.g. A and B or A and E) to treat patients suffering from neuromuscular conditions. The specification has provided no data to support Applicant's assertion that the administration of at least two neurotoxins to a patient suffering from a neuromuscular condition has an advantage over the administration of a single neurotoxin to a patient suffering from the same neuromuscular condition. In the instant case, Ludlow et al and Schantz et al teach that botulinum toxins types A and F can be used to treat neuromuscular disorders such as torticollis . Sugiyama et al teach that there are seven serotypes of botulinum toxin that antigenically differ but have a common and unique pharmacological action. Therefore, it would be obvious to substitute or combine different serotypes of botulinum toxin serotypes into a composition to treat neuromuscular conditions such as torticollis. There is nothing on the record to suggest that the combination of references would not suggest the claimed invention.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-9 and 17-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *This is a new matter rejection.*

The claims are drawn to a composition and a method of treating a patient suffering ~~form~~ from a neuromuscular disorder or condition, said method comprising the step of administering simultaneously to the patient a therapeutically effective amount of a combination of at least two neurotoxins selected from a group consisting of botulinum toxin types A,B,C,D,E,F and G, the combination of at least two neurotoxins including an amount of each selected neurotoxin such that the combination is effective in enhancing relief of muscle contraction relative to the relief provided by a reference composition including an amount of only one of the selected neurotoxins equal to the total amount of the neurotoxins of the combination.

The instant specification at page 11, Example 1, teach a method of treating a patient suffering from a joint dislocation by administering to the patient a composition having up to 500 units of botulinum toxin A and a lesser amount (not disclosed) of botulinum toxin B. The specification teaches that after several hours the joint is immobilized and muscle contractions are relieved. Example 2, page 13 of the instant specification discloses a method of treating a patient suffering form spasmodic torticollis as manifested by spasmodic or tonic contractions of the neck. The example teaches that treatment consisted of administering a composition comprising up to 300 units of botulinum toxin A and up to 300 units of botulinum toxin E. The example further discloses that after a few hours the symptoms are substantially alleviated. The specification fails to correlate a method of treating a patient suffering from a neuromuscular condition comprising administering to the patient a composition comprising botulinum at least two neurotoxins (e.g. A and B or A and E) with a method of treating a patient suffering from a neuromuscular condition comprising administering to the patient a composition comprising a "reference composition". The specification has failed to define or disclose the use of a "reference composition" to treat patients with neuromuscular conditions or disorders. No comparison of a composition comprising two or more neurotoxins and a reference composition used to treat patients with neuromuscular condition or disorder is made in the instant specification. Therefore, the claims as amended introduce new matter into the claims which is not supported by the instant disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-9 and 17-26 are rejected under 35 USC 112 second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-9 and 17-26 recites the limitation "reference composition.

Status of Claims

8. No claims are allowed.

Conclusion

9. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308–0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 872-9306.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (571) 272-0864.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov./>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vanessa L. Ford
Biotechnology Patent Examiner
July 20, 2004

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